

REMARKS

Claims 25, 26 and 36 have been canceled and claims 7, 8 and 30 have been amended to place the application in better form for examination and to further obviate the 35 U.S.C. §§102, 103 and 112 rejections set forth in the Office Action dated August 23, 2002. It is believed that none of these amendments constitute new matter. Withdrawal of these rejections is requested.

The Examiner has rejected claims 7, 8, 25, 26 and 36 under 35 U.S.C. §112, second paragraph as being indefinite. Specifically, claims 7, 8 and 30 as using improper Markush terminology, "... produced by tissue culture or mutagenesis and genetic engineering." Applicant has amended claims 7, 8 and 30.

Claims 25, 26 and 36 are rejected in the recitation of "nitrogen limiting soil under water-deficit conditions." Applicant has canceled claims 25, 26 and 36. Withdrawal of this rejection is respectfully requested.

Claims 1-14, 19-24, 27-29, 32-35 and 37-40 have been rejected under 35 U.S.C. §102(e) as being anticipated by Loh, et al., US Patent Application 2002/0058327 A1. Applicant submits that Loh et al. discusses the induction of nol A and the effect on nodulation. The present invention does not involve nol A. The present invention involves, in part, the construction of glyphosate-tolerant rhizobia which then give a competitive advantage over indigenous rhizobia for nodulation. Accordingly, withdrawal of this rejection is respectfully requested.

Claims 15-18, 30 and 31 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Loh, et al., US Patent Application 2002/0058327 A1, in view of Holmes, et al., US Patent No. 6,407,316. Applicant submits that Loh et al. discusses the induction of nol A and the effect on nodulation. The present invention does not involve nol A. The present invention involves, in part, the construction of glyphosate-tolerant rhizobia which then give a competitive advantage over indigenous rhizobia for nodulation.

In Holmes et al., herbicide resistant genes are mentioned merely as possible selectable markers, but the herbicide resistance gene is not the gene of interest. In the present invention, the herbicide tolerance gene is the gene of interest. Therefore, even

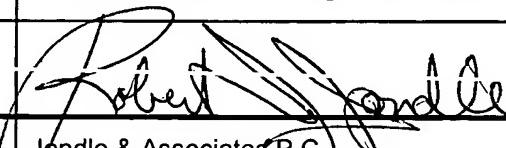
if the teachings of the references are combined, the combined teaching does not teach the one step assay required by the claims.

There must be a motivation cited to combine the references. It is improper simply to find all the elements of a claim amongst scattered pieces of prior art and then to reject the claim without indicating what motivation there would have been to one of ordinary skill in the art to have combined the references. This reasoning is set out in In re Rouffet, 47 U.S.P.Q.2d 1453.

"As this court has stated, 'virtually all [inventions] are combinations of old elements.' ... Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention." Id. At 1457.

The court in Rouffet goes on to state, "To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness." This makes clear that a motivation for combining references must be indicated in a proper rejection. One cannot simply point to the existence in the prior art of all of the individual elements of a claim. Accordingly, withdrawal of this rejection is respectfully requested.

In view of the above amendments and remarks, it is submitted that the claims satisfy the provisions of 35 U.S.C. §§ 102, 103 and 112 and are not obvious over the prior art. Reconsideration of this application and early notice of allowance is requested.

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Amended Claims: Version with markings to show changes made

Please cancel claims 25, 26 and 36.

Please amend claims 7, 8 and 30 as shown below:

7. (AMENDED) The method of claim 1, wherein said desired rhizobial strain is obtained by a method selected from the group consisting of selection for resistant variants produced by tissue culture, or mutagenesis and genetic engineering.
8. (AMENDED) The method of claim 2, wherein said desired rhizobial strain is obtained by a method selected from the group consisting of selection for resistant variants produced by tissue culture, or mutagenesis, and genetic engineering.
30. (AMENDED) The method of claim 27, wherein said herbicide of interest is selected from the group consisting of EPSPS inhibitors and or glutamine synthetase inhibitors.